

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

REMARKS/ARGUMENTS

Claims 15 and 17-28 are pending in this application. Claim 15 is independent. Claim 15 has been amended. Claims 1-14, 16, and 29-31 have been cancelled.

Claim Objections

The Patent Office objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully traverses. However, the claims have been amended and the specification is now believed to be in compliance.

Claim Rejection - 35 U.S.C. § 101

The Patent Office rejected claim 29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses the rejection. The Patent Office stated that one of ordinary skill in the art would read the limitations of the claim as software, per se, as non explicit or inherent statutory substrate to embody the instructions can be read into the claim. Office Action, page 3. Applicant respectfully disagrees. However, claim 29 has been cancelled.

The Patent Office rejected claims 1, 3-14, 30, and 31 alleges the claimed inventions are directed to non-statutory subject matter. Applicant respectfully traverses. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. MPEP §2106. If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. However, claims 1, 3-14, 30, and 31 have been cancelled.

Claims Rejections - 35 U.S.C. § 103(a)

The Patent Office rejected claims 1, 3-9, 13, 15, 17-23, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over *Okada et al.* (U.S. Patent No. 7,099,867) ("Okada") in view of *Mandato et al.* (U.S. Patent Publication No. 20010025280) ("Mandato"), in view of Hayes-Roth (U.S. Patent Publication No. 20020054072). Applicant respectfully traverses.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully submits amended claim 15 recites elements not disclosed, taught or suggested by any of the references cited by the Patent Office, either alone or in combination. For example, amended claim 15 generally recites a method for adding context to a chat transcript by analysing text of a first message. By contrast, *Okada*, *Mandato*, and *Hayes-Roth*, either alone or in combination, fail to disclose analysing text of a first message. The Patent Office cites to *Okada*, column 5, lines 1-6, as disclosing analysing text of a first message. Office Action, page 4. However, *Okada*, column 5, lines 1-6, recites "...speech is from another client PC or not in Step 206. If the new

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

speech is from another client PC, the procedure advances to Step 210. If, on the other hand, it is determined that the new speech is not from another client PC, that is, the new speech is of the subject client PC, the procedure advances to Step 220. Steps 210 - 214 and Steps 220 - 224 are..." Okada fails to disclose analysing text of a first message. Analysing text of a first message does not include, for example, determining whether speech is from a certain client PC, as recited by Okada. Determining whether speech is from a certain client PC is not the same as analysing text. Therefore, Okada lacks a method for adding context to a chat transcript by analysing text of a first message as required by amended claim 15.

Additionally, amended claim 15 recites a method for adding context to a chat transcript by assigning a verb to text of a first message. By contrast, Okada, Mandato, or Hayes-Roth fail to disclose a method for adding context to a chat transcript by assigning a verb to text of a first message. The Patent Office cites to Okada, column 12, lines 27-34, as disclosing the step of assigning a verb to text of a first message. However, Okada, column 12, lines 27-34, recites "Referring to the example shown in FIG. 7, the degrees of importance of all the keywords, 'patent', 'meeting', 'group' and 'badminton', are lowered by a degree of '1' for a period of three minutes, from 13:26 to 13:29, after the user uttered a speech at 13:26, '13:26 >user 2 < Mr. Matsuda is going to Tokyo!'. At 13:29, the degrees of importance are restored by raising them by '1'." Okada fails to disclose assigning a verb to text of a first message. Assigning a verb to text of a first message may include, for example, modifying a message of "Hi. How are you?" to read: "'Hi. How are you?', questioned Nicki." Assigning a verb to text of a first message is not the same as lowering or restoring the degree of importance of a keyword, as recited by Okada. Mandato or Hayes-Roth fail to disclose either the step of analysing text of a first message or the step of assigning a verb to text of a first message. The suggested combination that would result would still lack a method for adding context to a chat transcript by analysing text of said first message or by

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

assigning a verb to text of a first message as required by amended claim 15.
For at least the above reasons, claim 15 is allowable.

The Patent Office rejected claims 10, 14, 24, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Okada in view of Mandato in view of Hayes-Roth, further in view of Miyashita (U.S. Patent Publication No. 20030154250). Applicant respectfully traverses. Claims 10 and 14 have been cancelled. Claims 24 and 28 depend on allowable base claim 15. Therefore, claims 10 and 14.

Based on at least the rationale above, Applicant contends that none of the references cited by the Patent Office against the present invention, either alone or in combination, teach, disclose, or suggest the above referenced elements as claimed in the claims of the present application, and therefore, the above-cited references do not preclude patentability of the present invention under 35 U.S.C. § 103(a). Applicant further contends that it would have not been obvious to one of ordinary skill in the art at the time of the present invention to combine or modify any of the above cited references to arrive at the present invention as claimed. As a result, a *prime facie* case of obviousness has not been established for independent claim 15.

Amended independent claim 15 is allowable based on at least the reasons discussed in the previous paragraphs. Claims 17-28 depend on independent claim 15, which is allowable based on at least the rationale discussed in the previous paragraphs. Thus, dependent claims 17-28 are allowable based upon their dependence on allowable base claims.

Applicant respectfully requests entry of the amendments, and removal of all the pending rejections under 35 U.S.C. § 103(a) is respectfully requested. No new matter has been added by the amendments. Support for the amended claims may be found throughout the specification.

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

In this amendment, Applicant has amended claim 15 and cancelled claims 1-14, 16, and 29-31 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1-14, 15, 16, and 29-31, prior to this Amendment is not patentable over the art cited by the Patent Office. Claim 15 was amended and claims 1-14, 16, and 29-31 were cancelled in this Amendment solely to facilitate expeditious prosecution of the allowable subject matter noted by the Patent Office. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1-14, 15, 16, and 29-31, as presented prior to this Amendment and additional claims in one or more continuing applications.

CONCLUSION

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted, on behalf of,

IBM Corporation

Dated: June 11, 2008

By:



Gerald M. Keller
Reg. No. 60,179

Gerald M. Keller
SUITER • SWANTZ PC LLO
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile